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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,419	11/04/2003	Joseph Hessel	GP-302502	5797

7590 07/27/2005

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EXAMINER

RODRIGUEZ, SAUL

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/700,419

Applicant(s)

HESSELL ET AL.

Examiner

Saúl J. Rodríguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9 and 11 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

This communication is responsive to the amendment filed May 16, 2005.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 depends from a cancelled claim. For examination purposes it has been assumed that it was meant to depend from claim 7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

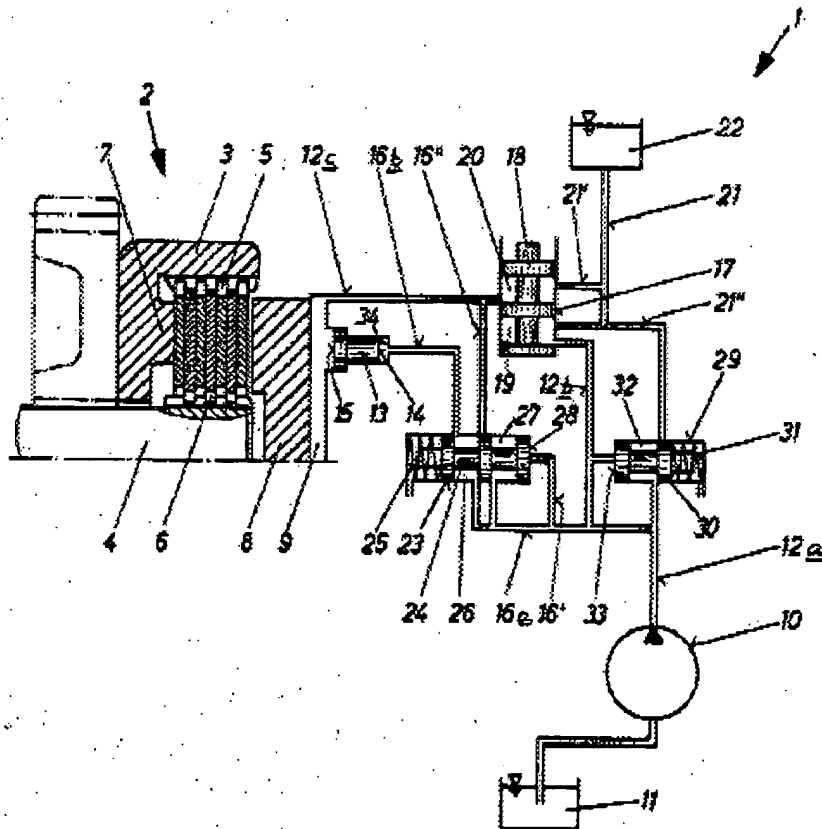
Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schacher et al. ('618).

Schacher et al. discloses an apparatus (Fig. 1) for applying and releasing a clutch piston (8) comprising a fill oil chamber having a first (9) and second (34) portions

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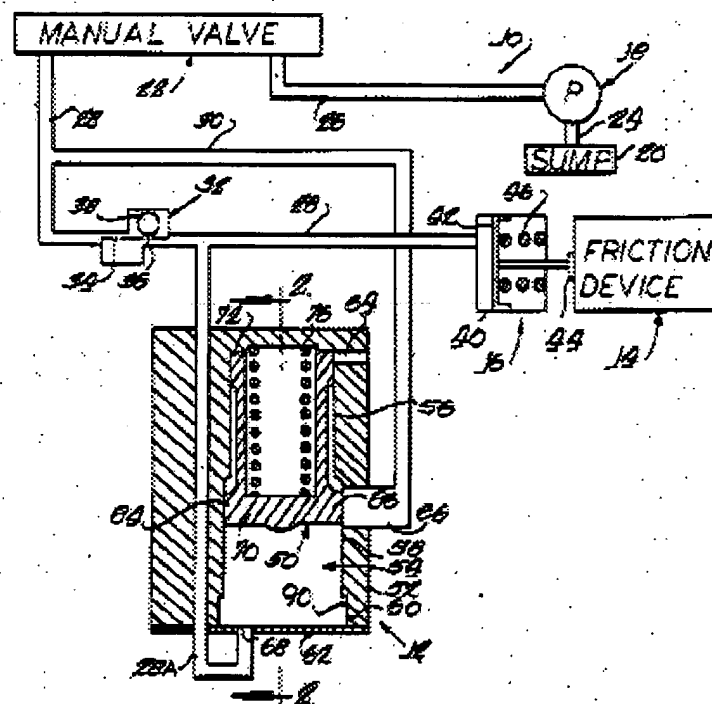
separated by a fill piston (13), a first passage (15), a second passage (16b), a third passage (12c), a fill control valve (24), a transmission line pressure by pump (10) or exhaust by relief valve (29), a spring (25); wherein pressure is controllable and selectively communicated with the third passage through passage/orifine (16").

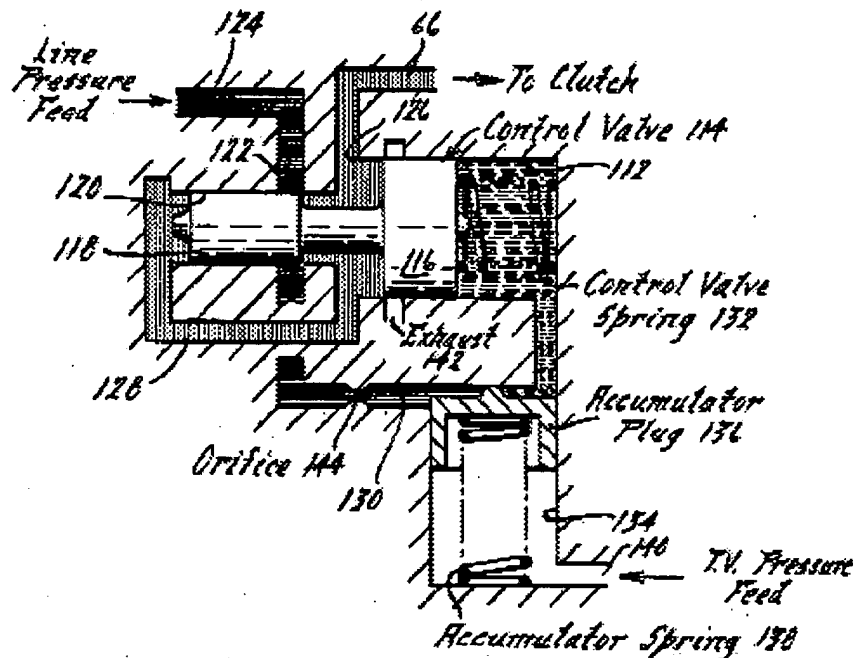
Concerning the position of the fill oil chamber being below the lowest sump level of a transmission, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the chamber in the claimed location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.



Claims 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Schacher et al. ('618) in view of Lemon ('063) or Emmadi ('346).

Schacher et al. do not show a snubber. However, snubbers are well known in the fluid handling art. For example, Lemon and Emmadi disclose fluid fill devices having auxiliary pistons (50; 118, 116) having such provision.





Then, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a snubber in the piston of Schacher in view of Lemon or Emmadi to manipulate the flow of fluid as the piston approaches its bottom.

### ***Claim Rejections - 35 USC § 103***

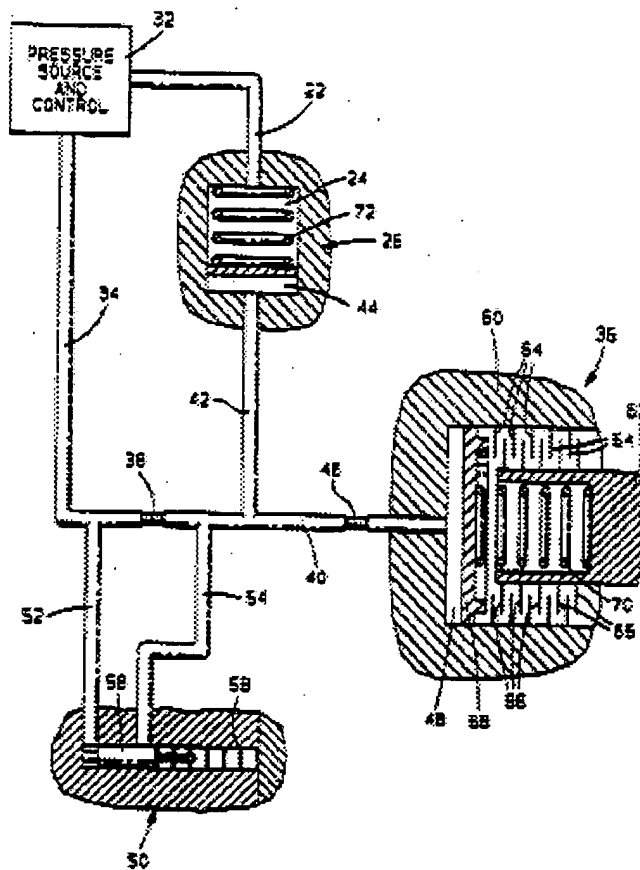
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schacher et al. ('618) in view Berger et al. ('727).

Schacher et al. does not teach a limit stop for the fill piston.

Berger et al., on the other hand, discloses an apparatus (Fig. 3) for applying and releasing a clutch piston (68), comprising a fill oil chamber (26) with first and second portions and a fill piston, a first passage (42), a second passage (22), , a third passage, and a fill control valve (32). Berger et al. also discloses a piston that bottoms out allowing the clutch chamber to be fed through the alternate passages.



Then it would have obvious to a person of to a person of ordinary skill in the art at the time the invention was made to limit the stroke of Schacher's piston in view of Berger to precisely meter the amount of fluid required for engaging the clutch.

***Allowable Subject Matter***

Claim 10 is allowed.

***Response to Arguments***

Applicant's arguments with respect to claims 17, 10 and 11 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sato ('168) and Schmid et al. ('929) disclose other pressure control systems having modulation and/or auxiliary fill pistons.

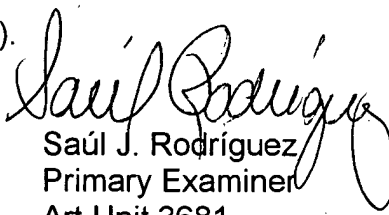
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saúl J. Rodríguez whose telephone number is (571) 272-7097. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Saúl J. Rodríguez  
Primary Examiner  
Art Unit 3681

  
SJR